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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,334

09/16/2003

Yukio Tajima

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ALEXANDRIA, VA 22320-4850

EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT

PAPER NUMBER

2145

MAIL DATE

DELIVERY MODE

09/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/662,334	Applicant(s) TAJIMA ET AL.	
	Examiner Jeffrey R. Swearingen	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/28/08 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-20 and 22 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant posits that "Examiner Swearingen stated during the personal interview that he did not understand" executable instructions for an authenticated user and non-executable instructions for a non-authenticated user. Applicant is directed to review the advisory action, in which the Office notes that during said personal interview, Applicant's representative concurred that these terms cannot be reasonably construed and make little to no sense at all.

4. Applicant argued the invention is not an alarm system because the claims do not state the word alarm. Applicant should argue the alleged difference between a network alert and a network alarm if the claims are not a network alarm system, as one of ordinary skill in the art considers the two terms to be synonymous. If Applicant is intending the invention to be limited to a photocopy machine, then Applicant should make the appropriate claim amendments to do so in order to forgo a reasonable interpretation of the claimed invention as a network alarm system.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1, 4, 7, 10, 13, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

8. As previously explained to Applicant's representative in the personal interview of 4/23/2008, a list of executable instructions for an authenticated user which includes non-executable instructions for the non-authenticated user is not reasonably construed by one of ordinary skill in the art. Applicant's representative conceded this point in the personal interview of 4/23/2008. It is further unclear how a non-executable instruction can exist in a list of executable instructions. By the very meaning of something being non-executable, it cannot also be considered executable. Applicant should provide some guidance on the intended claim construction of this language and make appropriate claim amendments, as an instruction cannot be considered both executable and non-executable simultaneously. As best interpreted for purposes of compact prosecution, the instructions are treated as the printer monitoring statistics selections where the user chooses what data to retrieve and analyze.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Pajak et al. (US 6,829,630).

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11. Note: Fuji Xerox Co., Ltd. of Tokyo, Japan (of the instant application) and Xerox Corporation (of the '630 patent) are not considered to be the same assignee. If the two are the same assignee, Applicant should inform the Office in the reply to the this office action.

12. In regard to claims 1, 4, 7, 10, 13 and 16, Pajak disclosed:

an instruction selection screen for displaying a list of available instructions for a non-authenticated user and for displaying a list of executable instructions for an authenticated user, wherein the list of available instructions includes non-executable instructions for the non-authenticated user; Figure 11, column 7, line 58 - column 8, line 7

a storing unit in which are stored (a) instruction data identifying a location of document data to be processed and identifying a content of plural service processes to be executed on the document data and (b) a correspondence relation between the instruction data that is to be processed when a specific event occurs and the specific event, wherein the plural service processes include at least one of copying, printing, scanning, sending facsimiles, receiving facsimiles and image processing; Figure 11, column 1, lines 16-19, column 1, lines 27-32, column 2, lines 23-31, column 4, lines 60-62

an identifying unit that receives a notification from at least one of plural service processing apparatuses each connected to a network that the specific event has occurred and that identifies the instruction data corresponding to the specific event based on the notification that has occurred on the basis of the correspondence relation; Figure 12, column 8, lines 8-20

an interpreting unit that interprets the instruction data identified by the identifying unit; and column 8, lines 22-53

a cooperative processing unit that makes the plural service processing apparatuses cooperatively execute the plural service processes on the document data on the basis of the interpretation of the instruction data of the interpreting unit. Column 8, lines 33-53

13. In regard to claim 2, 5, 8, 11, 14, 17, Pajak disclosed:

a setting unit that sets the instruction data and content of the specific event serving as a processing timing of the instruction data; and Figure 12, column 8, lines 16-19

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a generating unit that generates, on the basis of the content of the specific event set by the setting unit, the correspondence relation and instruction data for executing the plural service processes on the document data, and stores the correspondence relation and the instruction data in the storing unit.

Figure 12, column 8, lines 22-53

14. In regard to claim 3, 6, 9, 12, 15, 18, Pajak disclosed:

an authenticating unit that authenticates a creator of the instruction data, wherein the generating unit associates information of the creator of the instruction data with the instruction data and stores the information of the creator and the instruction data in the storing unit. Figure 12 shows authentication has occurred by allowing an account to be selected – "Enterprise" account number.

15. In regard to claim 19, Pajak disclosed:

the specific event is reception of document data from outside. Column 4, lines 50-54

16. In regard to claim 20, Pajak disclosed:

arrival of a predetermined time. Figure 11, column 8, lines 16-19

17. In regard to claim 22, Pajak disclosed:

the instruction data includes XML data. column 8, line 39

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Tomita US 7,080,121

20. Kajiwara et al. JP 5289187A

21. Ebner et al. US 5,305,055

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey R. Swearingen
Examiner
Art Unit 2145

/Jeffrey R. Swearingen/
Examiner, Art Unit 2145